



Application No. 10/822,051

Art Unit: 3728

Appeal Brief

November 26, 2007

**BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Appellant: RONALD JOHN ROSENBERGER

Application No.: 10/822,051 Art. Unit: 3728

Filing Date: 04/10/2004 Examiner: John T. Kavanaugh

Title: **SCENTED SHOE SOLES**

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**Ronald J. Rosenberger**

(Name of Appellant, assignee, or Registered Representative)

(Signature)

11/26/07

(Date of Signature)

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Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

**REVISED APPELLANT'S BRIEF ON APPEAL UNDER 37 CFR 41.37**

Dear Sir:

Appellants file this Revised Appellant's Brief on Appeal in response to the Notification of Non-Compliant Appeal Brief, mailed November 2, 2007, initially due December 2, 2007, further to Appellant's Brief on Appeal filed June 12, 2007, in response to the Final Office Action dated March 27, 2006, for which an Amendment and Response was filed June 27, 2006 as well as a Notice of Appeal also filed June 27, 2006, and for which a Petition For Revival of an Application for Patent Abandoned Unintentionally Under 37 CFR 1.137(b), statement and fee of \$750 under 1.17(m) for small entity were previously

filed, and which further included the Appeal Brief fee of \$250 under 37 C.F.R. § 1.17(c).

**Real Party in Interest (37 CFR 41.37(c)(1)(i))**

The Appellant-inventor, Ronald Rosenberger is the owner of entire interest in the above-identified patent application as the sole Appellant, and which interest has not been assigned.

**Related Appeals and Interferences (37 CFR 41.37(c)(1)(ii))**

There are no related appeals or interferences that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal and accordingly there are no decisions to provide copies herewith.

**Status of Claims (37 CFR 41.37(c)(1)(iii))**

Pending claims 1-7 and 9-21, with claims 2, 6, 7 and 18 now canceled, including independent claim 1, variously stand rejected under 35 USC 112.1, 102(b) or 103(a) as not enabled, or anticipated or obvious over the cited references. Appellants appeal and argue all of the remaining claims 1, 3-5 and 9-17 and 19-21, including independent claim 1.

Claims 1, 3-5 and 9-17 and 19-21 are pending on Appeal, with claims 2, 6, 7 and 18 now canceled to reduce issues on Appeal (to address rejections under 35 USC 112). Appellants now amend claims 12, 13, 15 and 20 to delete the term "etc." as objected by the Examiner to remove this issue on appeal. All of the remaining claims 1-5 and 9-17 and 19-21, including independent claim 1, are argued together.

**Status of Amendments (37 CFR 41.37(c)(1)(iv))**

The Examiner did not enter Appellant's Amendment under 37 CFR 116, filed June 27, 2006, in response to the final Office Action of March 27, 2006, as indicated in an Advisory Action of record but not received by Appellant in the mail. The Examiner maintained his rejections in the final Office Action as indicated in the Advisory Action.

Claims 1, 3-5 and 9-17 and 19-21 are pending on Appeal, with claims 2, 6, 7 and 18 now canceled to reduce issues on Appeal (to address rejections under 35 USC 112). Appellants now amend claims 12, 13, 15 and 20 to delete the term "etc." as objected by the Examiner to remove this issue on appeal. All of the remaining claims 1, 3-5 and 9-17 and 19-21, including independent claim 1, are argued together.

**Summary of Claimed Subject Matter (37 CFR 41.37(c)(1)(v))**

The presently claimed invention is specific to a shoe sole for a shoe comprising at least one scented plug or insert (as supported, e.g., at pages 3-7 of the specification). The following table provides independent claim 1 and its corresponding support in the specification.

<b><u>Independent claim</u></b>	<b><u>Specification Support</u></b>
<p>1. A shoe sole for a shoe comprising at least one scented material/formulation compound as a component of the shoe sole or as provided in a shoe sole plug or insert, where said scented material/formulation compound comprises at least one scent or fragrance</p> <p>(A) where said scented material/formulation compound gives off a desired aroma when said shoe sole is at rest;</p> <p>(B) where said scented material/formulation compound gives off a desired aroma when said shoe sole is in normal use due to friction, heat buildup, and wear; or</p> <p>(C) where said novelty scented material/formulation compound gives off a</p>	<p>p. 3-7: The present invention involves scenting the shoe's sole material/formulation compound(s) with at least one novelty scent or fragrance. The term "novelty scented shoes" is herein defined as shoes comprising scented sole material/formulation compound(s).</p> <p>In many scent related disclosures not having anything to do with the present invention, scent is used to mask offensive odors, such as room deodorizers. This is not the case with the present invention, where the unique aroma due to the novelty scent or fragrance added to the material/formulation compound is a salient, distinguishing, and marketable feature of the shoe comprising the novelty scented shoe sole, and may comprise any desired novelty scent or fragrance. The shoe comprising the novelty scented shoe sole gives off a unique aroma when the shoe is at rest, and when the shoe is in use. Friction, heat buildup, and wear due to use is an effective means of releasing the aroma;</p>

desired aroma when normal wear of said shoe sole exposes fresh surface area of said scented material/formulation compound, and wherein said desired aroma comprises a salient, distinctive, and marketable feature of said shoe.	and wear of the novelty scented shoe sole serves to expose fresh surface area of the novelty scented material/formulation. Wear and tear of a given shoe has the greatest impact on the sole of the shoe, and it is this wear and tear aspect that enable special dynamics of the disclosed sole to emerge. For purposes of this disclosure, the term "novelty scented shoes" refers to shoes comprising novelty scented shoe soles.
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**Grounds of Rejection to be reviewed on Appeal (37 CFR 41.37(c)(1)(vi))**

The Examiner did not enter Appellant's Amendment under 37 CFR 116, filed June 27, 2006, in response to the final Office Action of March 27, 2006, as indicated in an Advisory Action of record but not received by Appellant in the mail. The Examiner maintained his rejections in the final Office Action as indicated in the Advisory Action.

Claims 1, 3-5 and 9-17 and 19-21 are pending on Appeal, with claims 2, 6, 7 and 18 now canceled to reduce issues on Appeal (to address rejections under 35 USC 112). Appellants now amend claims 12, 13, 15 and 20 to delete the term "etc." as objected by the Examiner to remove this issue on appeal. All of the remaining claims 1, 3-5 and 9-17 and 19-21, including independent claim 1, are argued together.

1. The Examiner objects to the drawings under 37 CFR 1.83(a) and 35 USC 132 for adding new matter.
2. The Examiner rejects claim 9 under 35 USC, Section 112, first paragraph.
3. The Examiner rejects claims 1-7 and 9-21 under 35 USC 112, second paragraph, as indefinite.
4. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Hartung, et al. (US 4,257,176).

5. Claims 1, 6-7, 9, 11, 14, 15, 17, 18, 19-21 are rejected under 35 U.S.C. 102(b), as being anticipated by Laughlin, et al. (US 5,732,485).
6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Laughlin '485 in view of Maples (US 5,024,008).
7. Claims 3 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laughlin '485 in view of Williford (US 5,261,169).
8. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laughlin '485 in view of O'Brien (US 5,039,243).

**Arguments (37 CFR 41.37(c)(1)(vii))**

The Examiner did not enter Appellant's Amendment under 37 CFR 116, filed June 27, 2006, in response to the final Office Action of March 27, 2006, as indicated in an Advisory Action of record but not received by Appellant in the mail. The Examiner maintained his rejections in the final Office Action as indicated in the Advisory Action.

Claims 1, 3-5 and 9-17 and 19-21 are pending on Appeal, with claims 2, 6, 7 and 18 now canceled to reduce issues on Appeal (to address rejections under 35 USC 112). Appellants now amend claims 12, 13, 15 and 20 to delete the term "etc." as objected by the Examiner to remove this issue on appeal. All of the remaining claims 1, 3-5 and 9-17 and 19-21, including independent claim 1, are argued together.

**Argument 1 under (37 CFR 41.37(c)(1)(vii)):**

The Examiner objects to the drawings under 37 CFR 1.83(a) and 35 USC 132, asserting that new drawings should be provided showing each of the claimed features of the invention, including "shoe sole," "scented compound," "visual aspect," "two or more plugs or inserts".

Appellant replies and points out that the Examiner specifically requested in the non-final Office Action date 11-14-05 that a new drawing be provided that included: “shoe sole,” “scented material/formulation compound,” “void,” “receptacle,” “hole,” “O-ring,” “multi-sectional construction,” “visual aspect,” “two or more plugs or inserts.”

Appellant provided amended Figure 1 in response to the non-final office action, which included, inter alia, “shoe sole,” “scented material/formulation compound,” “void,” “receptacle,” “hole,” “O-ring,” “multi-sectional construction,” “visual aspect,” “two or more plugs or inserts,” which are each of the elements requested by the Examiner. Appellant thus provided each of the requested components according to the amended claims in the response to the non-final Office Action as specifically stated by the Examiner.

However, in the final Office Action dated March 27, 2006, the Examiner repeated the same rejection, apparently not considering the Figure submitted by Appellant or not considering the specific elements that had been requested by the Examiner.

Since Appellant has provided each of the elements specifically requested by the Examiner that corresponded to the pending claims, this rejection should be reversed as being in error.

Argument 2 under (37 CFR 41.37(c)(1)(vii):

The Examiner rejects claim 9 under 35 USC, Section 112, first paragraph, as failing to comply with the enablement requirement, asserting that claim 9 lacks clarity by the use of the term “void can accommodate said at least one scented plug or insert comprising any embodiment of an O-ring around the non-wearing circumference of the entire shoe,” as the description of the “ring” in the specification was not understood by the Examiner.

The objected-to term is fully supported by the present specification, e.g., inter alia, as follows at the top of page 11:

A novelty scented plug or insert can be installed on the disclosed shoe sole that comprises novelty scented material/formulation compound, and/or pheromones, or it may be installed on shoe soles not comprising any of the abovementioned attributes. What is important is that the shoe sole comprises at least one void anywhere on the surface of the sole where the void comprises a receptacle that is intended for and allows for the insertion of at least one novelty plug or insert. A clarification is in order here. While the term "anywhere on the surface" mostly pertains to the wearable surface of the shoe sole, a void *can* occur on a non-wearing surface of the sole, where the novelty scented plug exists to emit scent *sans* wear. Such would comprise a void or receptacle for a novelty plug or insert on the side of the sole, or even a void or receptacle *around* the non-wearing circumference of the entire shoe sole, and/or around the non-wearing circumference of the heel portion of the sole, and/or around the non-wearing circumference of the non-heel portion of the sole, any of which that are visible from above when the shoe is worn on the user's foot. The void(s) can allow for, say, one or more scented and sparkly novelty plug(s) or insert(s) comprising one or more "O" ring(s) comprising novelty scented material/formulation compound, where a given "O" ring is elastic or semi-elastic, and perhaps has qualities similar to a rubber band or an elastic hair band that can be stretched on or off the sole of the shoe, and can be easily replaced at will.

Accordingly the specification fully discloses and enables the rejected term according to 35 USC 112, first and second paragraphs.

This rejection should be reversed as being in error.

Argument 3 under (37 CFR 41.37(c)(1)(vii):

The Examiner has rejected claims 1-7 and 9-21 under 35 USC 112, second paragraph, as indefinite, for the reasons presented on pages 4-5 of the Office Action, in particular objecting to:

- (a) the terms "etc.", generally in the claims;

- (b) the functional recitation of scented material/compound while the term  
scented material is positively recited and “void creating means” in claim 6,
- (c) the recitation of the term “does not comprise said at least one scented ...  
smoking means” is not understood as to what is being claimed in claim 7;  
and
- (d) the recitation of the plug or insert having multi-sectional construction not  
being understood in claim 18.

Although Appellant disagrees with the Examiner, and solely to further prosecution and to reduce issues on appeal, Appellant now cancels claims 6, 7 and 18, and amended claims 12, 13, 15 and 20, rendering this rejection moot.

Accordingly, Appellant respectfully requests withdrawal of this rejection.

Argument 4 under (37 CFR 41.37(c)(1)(vii):

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Hartung, et al. (US 4,257,176). Hartung, et al. disclosed, per the abstract: “An insole for footwear has odor masking or malodor counteractant material dissolved, trapped or encapsulated in a somewhat resilient resin coating through which it will progressively migrate or bleed under application of foot loads, foot perspiration and elevated foot temperatures to the surface of the coating to be released into the footwear to mask or counteract foot odors.”

However, the cited reference has nothing to do with the claimed invention as recited in the pending claims and in the specification. Appellant’s invention claims and describes an exterior sole that has scented material added to the exterior sole material itself or to inserts that gives off a novelty scent (novelty has been removed due to rejections by the Examiner).

The claimed invention has nothing to do with insoles and the Examiner has simply redefined the claimed invention to include insoles in order to read the claims onto the prior art when the claims and the specification have nothing to do with insoles. This



is specifically stated and taught by the present specification, e.g., under the Summary of the Invention, second paragraph on page 6: "In many scent related disclosures not having anything to do with the present invention, scent is used to mask offensive odors, such as room deodorizers."

Claim 1 recites a shoe sole for a shoe (which does not include an insole, the normal use of the term sole refers to the exterior sole only) as an exterior sole, as fully supported by the present specification, e.g., at pages 3-7.

Hartung '176 is an insole that is separate and distinct from the claimed sole of a shoe, where the insole is inserted into the inside of the shoe as distinct from the existing exterior sole of the shoe. As distinct from the presently claimed invention, an insole is separate and distinct from a shoe sole. An insole is an after market product that is inserted inside a shoe that already has a sole. An insole is put inside shoe, separate from the shoe itself.

Additionally the presently claimed invention provides a novelty scent due to the presence of a scented material that is on the exterior of the shoe sole, that gives off a novelty scent due to wear of the exterior sole from normal use or wear.

Unlike the present invention, Hartung does not come in direct contact with indoor and outdoor ground surfaces such as pavements, floor coverings, etc. An intended purpose for Hartung is "to mask or counteract foot odors", whereby the present invention has no deodorizing aspects for insoles, but is rather meant to provide a scent to the exterior outer sole of the shoe, boot, etc.

Thus, the present invention does not recite, disclose or include insoles, but discloses and claims exterior soles that have scented or fragrant inserts or plugs have a desired aroma. Accordingly, the cited reference fails to disclose each and every element of the present claims.

Furthermore, the present invention “teaches away” from the cited reference with regards to the intended purpose of the use of scent. In Hartung, the primary intended purpose of scent is to mask or counteract foot odors, whereby the present invention teaches away from Hartung in that the primary intended purpose of the scent is as an attractive feature to the shoe wearer that influences the purchasing and wearing of the shoe, and therefore, unlike Hartung, has no relation whatsoever to the addressing or mitigating of foot odor issues.

Accordingly, the present claims distinguish over and teach away from the cited reference. Accordingly, Appellant respectfully requests reconsideration and withdrawal of this rejection.

This rejection should be reversed as being in error.

Argument 5 under (37 CFR 41.37(c)(1)(vii):

Claims 1, 6-7, 9, 11, 14, 15, 17, 18, 19-21 are rejected under 35 U.S.C. 102(b), as being anticipated by Laughlin, et al. (US 5,732,485). Laughlin, et al. comprises, per the abstract: “A deodorizer for masking foot and shoe odors through controlled release of fragrance...” whereby said deodorizer is installed in “the interior surface of a shoe”, where the user’s foot resides, i.e., the insole.

Claims 6, 7 and 18 are now canceled rendering the rejection of these claims moot.

Laughlin ‘485, as is Hartung ‘176 relates to an insole to mask or counteract foot odors using a deodorizing insole, whereby the present invention has no deodorizing aspects for insoles, but is rather meant to provide a scent to the exterior outer sole of the shoe. Additionally, there is no suggestion in Laughlin for scenting the exterior sole of a shoe, as presently claimed.

However, the cited reference has nothing to do with the claimed invention as recited in the pending claims and in the specification. Appellant’s invention claims and

describes an exterior sole that has scented material added to the exterior sole material itself or to inserts that gives off a novelty scent (novelty has been removed due to rejections by the Examiner).

The claimed invention has nothing to do with insoles and the Examiner has simply redefined the claimed invention to include insoles in order to read the claims onto the prior art when the claims and the specification have nothing to do with insoles. This is specifically stated and taught by the present specification, e.g., under the Summary of the Invention, second paragraph on page 6: "In many scent related disclosures not having anything to do with the present invention, scent is used to mask offensive odors, such as room deodorizers."

Claim 1 recites a shoe sole for a shoe (which does not include an insole, the normal use of the term sole refers to the exterior sole only) as an exterior sole, as fully supported by the present specification, e.g., at pages 3-7.

Laughlin is an insole that is separate and distinct from the claimed sole of a shoe, where the insole is inserted into the inside of the shoe as distinct from the existing exterior sole of the shoe. As distinct from the presently claimed invention, an insole is separate and distinct from a shoe sole. An insole is an after market product that is inserted inside a shoe that already has a sole. An insole is put inside shoe, separate from the shoe itself.

Additionally the presently claimed invention provides a novelty scent due to the presence of a scented material that is on the exterior of the shoe sole, that gives off a novelty scent due to wear of the exterior sole from normal use or wear.

Unlike the present invention, Laughlin does not come in direct contact with indoor and outdoor ground surfaces such as pavements, floor coverings, etc. An intended purpose for Laughlin is "to mask or counteract foot odors", whereby the present invention has no deodorizing aspects for insoles, but is rather meant to provide a scent to the exterior outer sole of the shoe, boot, etc.

Thus, the present invention does not recite, disclose, include or suggest insoles, but discloses and claims scented shoe soles. Accordingly, the cited reference fails to disclose, teach or suggest each and every element of the present claims.

Furthermore, the present invention “teaches away” from the cited reference with regards to the intended purpose of the use of scent. In Laughlin, the primary intended purpose of scent is to act as “[a] deodorizer for masking foot and shoe odors”, whereby the present invention teaches away from Laughlin in that the primary intended purpose of the scent is as an attractive feature to the shoe wearer that influences the purchasing and the wearing of the shoe, and therefore, unlike Laughlin, has no relation whatsoever to the addressing or mitigating of foot and shoe odor issues.

Accordingly, the present claims distinguish over and teach away from the cited reference. Accordingly, Appellant respectfully requests reconsideration and withdrawal of this rejection.

This rejection should be reversed as being in error.

Argument 6 under (37 CFR 41.37(c)(1)(vii):

Claim 2 is rejected under 35 U.S.C, 103(a) as being unpatentable over Laughlin ‘485 in view of Maples.

Maples (US 5,024,008) comprises “a rubber overshoe to be worn over a boot worn by the hunter” with an animal “scent dispenser...which is attached to the overshoe for dispensing scent on the ground as the hunter walks” where the animal “scent dispenser is isolated from the boot so that the overshoe and dispenser may be removed from the boot...”. The rubber overshoe, which is *removable*, and is *not inherent* to the boot itself, is not scented, and unlike the present invention which claims normal wear of said shoe sole exposes fresh surface area of said scented material/formulation compound releases a desired aroma, and further in Maples, the “...scent source means includes a sponge and animal lure impregnated therein”. The presently claimed

invention further does not include the use of an overshoe with a “sponge dispenser and animal lure impregnated therein” to dispense an animal luring scent.

Additionally, Laughlin fails to teach an exterior outer sole as presently claimed, and the cited references do not teach the combination made by the Examiner, who is using hindsight provided by the present specification.

However, solely to reduce issues on Appeal, Appellant cancels claim 2 for the purpose of this Appeal, rendering this rejection moot.

Argument 7 under (37 CFR 41.37(c)(1)(vii):

Claims 3 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laughlin ‘485 in view of Williford. Williford (US 5,261,169) discloses where the “...article is a shoe insole and the active composition is an anti-microbial powder.” Again, the examiner has mischaracterized the reference. In actuality, Williford more closely resembles Laughlin than the present disclosure in that the insole is installed in the interior surface of a shoe where the user’s foot resides, and comes in direct contact with the foot of the shoe wearer.

An intended purpose for Laughlin and Williford, is to mask or counteract foot odors using a deodorizing/counteracting insole, whereby the present invention has no deodorizing/anti-microbial agent for insoles, but is rather intended to provide a scent to the exterior outer sole of the shoe, boot, etc. Additionally, there is no suggestion in Laughlin and Williford for scenting the exterior outer sole of a shoe or boot, as presently claimed.

However, the cited reference has nothing to do with the claimed invention as recited in the pending claims and in the specification. Appellant’s invention claims and describes an exterior sole that has scented material added to the exterior sole material itself or to inserts that gives off a novelty scent (novelty has been removed due to rejections by the Examiner).

The claimed invention has nothing to do with insoles and the Examiner has simply redefined the claimed invention to include insoles in order to read the claims onto the prior art when the claims and the specification have nothing to do with insoles. This is specifically stated and taught by the present specification, e.g., under the Summary of the Invention, second paragraph on page 6: "In many scent related disclosures not having anything to do with the present invention, scent is used to mask offensive odors, such as room deodorizers."

Claim 1 recites a shoe sole for a shoe (which does not include an insole, the normal use of the term sole refers to the exterior sole only) as an exterior sole, as fully supported by the present specification, e.g., at pages 3-7.

Laughlin is an insole that is separate and distinct from the claimed sole of a shoe, where the insole is inserted into the inside of the shoe as distinct from the existing exterior sole of the shoe. As distinct from the presently claimed invention, an insole is separate and distinct from a shoe sole. An insole is an after market product that is inserted inside a shoe that already has a sole. An insole is put inside shoe, separate from the shoe itself.

Additionally the presently claimed invention provides a novelty scent due to the presence of a scented material that is on the exterior of the shoe sole, that gives off a novelty scent due to wear of the exterior sole from normal use or wear.

Unlike the present invention, Laughlin does not come in direct contact with indoor and outdoor ground surfaces such as pavements, floor coverings, etc. An intended purpose for Laughlin is "to mask or counteract foot odors", whereby the present invention has no deodorizing aspects for insoles, but is rather meant to provide a scent to the exterior outer sole of the shoe, boot, etc.

Thus, the present invention does not recite, disclose, include or suggest insoles, but discloses and claims scented shoe soles. Accordingly, the cited reference fails to disclose, teach or suggest each and every element of the present claims.

Looking at this obviousness rejection under the Graham factors, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined.

In particular the scope and content of the prior art teach that inner soles can be scented to address foot odor according to Laughlin '485 and foot microbial contamination that causes foot odor or fungus infection by adding an antimicrobial composition to the inner soles of a shoe according to Williford '169. The present invention provides an exterior outer shoe sole that incorporates a unique scent that is released upon wear of the shoe and thus provides a completely different function, as well as structure, from that of the cited art.

One of ordinary skill in the art would be taught either to scent inner soles to address foot odor or to add a microbial powder to the inner sole to address foot odor or infection, where one of ordinary skill would either be a foot inner sole engineer designing deodorants for inner soles *or* an antimicrobial engineer or designer for adding such to an inner sole, which would not present any of the functions of the present invention, and which would rely on a different person of ordinary skill in the areas of exterior outer sole engineering and fragrance engineering to add fragrance to the composition of an exterior outer sole of a shoe that was released as a unique aroma to the shoe wearer upon ordinary wear of the shoe by said wearer (not deodorant or microbial powder in the inner sole to address foot odor or infection).

Additionally, in Williford, the primary intended purpose of any use of anti-microbial powder is greatly different than the smoking compound comprising the present invention. Williford teaches that the primary intended purpose of the anti-microbial powder is to counteract foot odors, whereby the present invention "teaches away"

from Williford in that the primary intended purpose of the smoking compound (sans any anti-microbial agent) is as an amusing and attractive feature to the shoe wearer that influences the purchasing and the wearing of the shoe, and, unlike Williford, has no relation whatsoever to the addressing or mitigating of foot odor issues. Williford further teaches away from the present invention that the anti-microbial powder entails contact with the actual foot of the wearer, whereby the smoking compound of the present invention is triggered by wear and tear of the exterior sole due to direct contact with indoor and outdoor ground surfaces such as pavements, floors coverings, etc., whereby the smoking compound does not have direct contact with the actual foot of the wearer.

Accordingly the application of the Graham factors, as well as how the cited references “teach away” from the present invention with regards to the intended purpose relating to the use of scent, or powder and smoking compounds, results in the inescapable conclusion that the presently claimed invention is not obvious over the cited references, which one of ordinary skill would not and could not combine to make obvious the presently claimed invention.

Thus, the present invention does not recite, disclose, include or suggest insoles, but discloses and claims scented shoes having scented exterior soles further comprising a smoking compound. Accordingly, the cited references fail to disclose, teach or suggest each and every element of the present claims.

Accordingly, the present claims distinguish over the cited reference(s). Accordingly, Appellant respectfully requests reconsideration and withdrawal of this rejection.

This rejection should be reversed as being in error.

Argument 8 under (37 CFR 41.37(c)(1)(vii):

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) are being unpatentable over Laughlin ‘485 in view of O’Brien. O’Brien (US 5,039,243) discloses fragrance releasing crayons. In the present invention, the colored sole is visible from the



*outside* of the shoe as it is worn, whereas with Laughlin '485, the colored scenting means could only be visible from the *inside* of the shoe. There is no suggestion or motivation to combine a reference for scented crayons with deodorizing insoles, such that the combination is improper under the MPEP.

However, the cited reference has nothing to do with the claimed invention as recited in the pending claims and in the specification. Appellant's invention claims and describes an exterior sole that has scented material added to the exterior sole material itself or to inserts that gives off a novelty scent (novelty has been removed due to rejections by the Examiner).

The claimed invention has nothing to do with insoles and the Examiner has simply redefined the claimed invention to include insoles in order to read the claims onto the prior art when the claims and the specification have nothing to do with insoles. This is specifically stated and taught by the present specification, e.g., under the Summary of the Invention, second paragraph on page 6: "In many scent related disclosures not having anything to do with the present invention, scent is used to mask offensive odors, such as room deodorizers."

Claim 1 recites a shoe sole for a shoe (which does not include an insole, the normal use of the term sole refers to the exterior sole only) as an exterior sole, as fully supported by the present specification, e.g., at pages 3-7.

Laughlin is an insole that is separate and distinct from the claimed sole of a shoe, where the insole is inserted into the inside of the shoe as distinct from the existing exterior sole of the shoe. As distinct from the presently claimed invention, an insole is separate and distinct from a shoe sole. An insole is an after market product that is inserted inside a shoe that already has a sole. An insole is put inside shoe, separate from the shoe itself.

Additionally the presently claimed invention provides a novelty scent due to the presence of a scented material that is on the exterior of the shoe sole, that gives off a novelty scent due to wear of the exterior sole from normal use or wear.

Unlike the present invention, Laughlin does not come in direct contact with indoor and outdoor ground surfaces such as pavements, floor coverings, etc. An intended purpose for Laughlin is “to mask or counteract foot odors”, whereby the present invention has no deodorizing aspects for insoles, but is rather meant to provide a scent to the exterior outer sole of the shoe, boot, etc.

Thus, the present invention does not recite, disclose, include or suggest insoles, but discloses and claims scented shoe soles. Accordingly, the cited reference fails to disclose, teach or suggest each and every element of the present claims.

Furthermore, the present invention “teaches away” from the cited reference with regards to the intended purpose of the use of scent. In Laughlin, the primary intended purpose of scent is to act as “[a] deodorizer for masking foot and shoe odors”, whereby the present invention teaches away from Laughlin in that the primary intended purpose of the scent is as an attractive feature to the shoe wearer that influences the purchasing and the wearing of the shoe, and therefore, unlike Laughlin, has no relation whatsoever to the addressing or mitigating of foot and shoe odor issues.

The only intended purpose for Laughlin ‘485 is to mask or counteract foot odors using a deodorizing insole, whereby the present invention has no deodorizing aspects for insoles, but is rather meant to provide a scent to the exterior outer sole of the shoe, boot, etc. Additionally, there is no suggestion in Laughlin for scenting the exterior sole of a shoe or boot, as presently claimed, and O’Brien’s suggestion for scented crayons in no way makes up for the deficiencies of Laughlin in failing to suggest the presently claimed shoe having scented exterior outer soles. As these references are in no way related, the Examiner only could have used hindsight provided by the present specification to make this combination of references.

Looking at this obviousness rejection under the Graham factors, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art

resolved. Against this background the obviousness or nonobviousness of the subject matter is determined.

In particular the scope and content of the prior art teach that inner soles can be scented to address foot odor according to Laughlin '485 and scented crayons according to O'Brien '243. The present invention provides an exterior outer shoe sole that incorporates a unique scent that is released upon wear of the shoe and thus provides a completely different function as well as structure from that of the cited art.

One of ordinary skill in the art would be taught either to scent inner soles to address foot odor or to scent crayons for drawing with an added fragrance, where one of ordinary skill would either be a foot inner sole engineer designing deodorants for inner soles or a crayon designer for adding fragrance to a crayon, which would not present any of the functions of the present invention, and which would rely on a different person of ordinary skill in the areas of outer sole engineer and fragrance engineer to add fragrance to the composition of an outer sole of a shoe that was released as a unique aroma to the shoe wear upon ordinary wear of the shoe by the wearer (not deodorant or microbial powder in the inner sole to address foot odor or infection).

As discussed earlier, Laughlin '485 "teaches away" from the present invention with regards to the intended purpose of the use of scent. Furthermore, Laughlin and O'Brien '243 also "teach away" from each other with regards to the intended purpose of the use of scent! Laughlin teaches where the primary intended purpose of scent is to act as "[a] deodorizer for masking foot and shoe odors", whereby O'Brien teaches that scented crayons function as "a fragrance releasing device" whose scent is obviously *not* intended to mask odors, but rather where the intended purpose of the use of scent comprises an attractive feature to the crayon user that influences the purchasing and use of the scented crayons.

Accordingly the application of the Graham factors, as well as how the cited references “teach away” from each other with regards to the intended purpose relating to the use of scent, results in the inescapable conclusion that the presently claimed invention is not obvious over the cited references, which one of ordinary skill would not and could not combine to make obvious the presently claimed invention.

Thus, the present invention does not recite, disclose, include or suggest insoles, but discloses and claims shoes having scented exterior shoe shoes. Accordingly, the cited references fail to disclose, teach or suggest each and every element of the present claims. Reconsideration and withdrawal of this rejection is requested.

This rejection should be reversed as being in error.

### **Conclusion**

In view of the above arguments and evidence of record, Appellants request that the Examiner’s objections and rejections be reversed and the case remanded to the Examiner for allowance.

The Examiner is invited to contact Appellant with any questions or comments.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Ronald J. Rosenberger".

Ronald J. Rosenberger

Appellant

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Date: November 26, 2007

**CLAIMS ON APPEAL**

1. (Previously Amended) A shoe sole for a shoe comprising at least one scented material/formulation compound as a component of the shoe sole or as provided in a shoe sole plug or insert, where said scented material/formulation compound comprises at least one scent or fragrance
  - (a) where said scented material/formulation compound gives off a desired aroma when said shoe sole is at rest;
  - (b) where said scented material/formulation compound gives off a desired aroma when said shoe sole is in normal use due to friction, heat buildup, and wear; or
  - (c) where said novelty scented material/formulation compound gives off a desired aroma when normal wear of said shoe sole exposes fresh surface area of said scented material/formulation compound,and wherein said desired aroma comprises a salient, distinctive, and marketable feature of said shoe.
2. (Now Canceled) The shoe sole of claim 1, further comprising including where said scented material/formulation compound comprises at least one desired pheromone in addition to, or in place of, said at least one scent or fragrance.
3. (Previously Amended) The shoe sole of claim 1, further comprising including where said scented material/formulation compound comprises at least one smoking means in addition to, or in place of, said at least one scent or fragrance and/or at least one pheromone.
4. (original) The shoe sole of claim 1, further comprising including where said shoe sole comprises materials that are colored in accordance to the scent of said shoe sole.
5. (original) The shoe sole of claim 1, further comprising including where a given pair of shoes comprise a mixed set, where each shoe sole in said given pair comprises a different scent.
6. (Now Canceled)

7. (Now Canceled)
8. (Canceled)
9. (Previously Amended) The void of claim 6, further comprising including where said void can accommodate said at least one scented plug or insert comprising any embodiment of an "O" ring around the non-wearing circumference of the entire shoe sole, and/or around the non-wearing circumference of the heel portion of said shoe sole, and/or around the non-wearing circumference of the non-heel portion of said shoe sole; or where said "O" ring is in or on the wear surface of said shoe sole.
10. (Previously Amended) The void of claim 6, further comprising including where said void can accommodate two or more plugs or inserts, either along the depth of said void, side-by-side along/across the opening gap of said void, or both.
11. (Previously Amended) The scented plug or insert of claim 6, comprising where said plug or insert comprises any shape, design, size or depth, comprising where said plug or insert comprises any material composition, comprising where said plug or insert comprises any color or any colors, and comprising where said plug or insert is designed for or is able to be modified to be inserted, installed and/or secured in said void by any possible inserting, installing or securing means; further comprising including where said plug or insert is removable from said void using any removing means.
12. (Currently Amended) The scented plug or insert of claim 11, comprising where said plug or insert may be formed by any forming means, where said any forming means comprises any means of molding, casting, die cutting, extruding and cutting, molding and cutting, or casting and cutting, ~~etc.~~
13. (Previously Amended) The scented plug or insert of claim 11, comprising where said plug or insert comprises semi-solids that are introduced into said void using any void-filling means, where said any void-filling means comprises any means of pouring, pumping, injecting, or spraying, ~~etc.~~
14. (Previously Amended) The material composition of claim 11, further comprising including where said material composition comprises at least one scent or fragrance and/or pheromone.

15. (Previously Amended) The material composition of claim 11, further comprising including where said material composition comprises at least one visual aspect, where said visual aspect comprises any or interesting appearance items including items that are reflective, refractive, sparkling, shining, holographic, jewel-like, pearlescent, fluorescent, glow-in-the dark, ~~etc.~~, where said visual aspect does not produce light and does not comprise the use of a chemical reaction that produces light.
16. (original) The material composition of claim 11, further comprising including where said material composition comprises at least one smoking means.
17. (Previously Amended) The scented plug or insert of claim 11, comprising where a singular said scented plug or insert comprises, in addition to at least one material composition, any one, or any combination or permutation comprising more than one, of the following attributes: at least one color; at least one scent and/or fragrance; at least one pheromone; at least one visual aspect; or at least one smoking means.
18. (Now Canceled)
19. (Previously Amended) The scented plug or insert of claim 11, comprising where said scented plug or insert may be either factory installed on said shoe during the manufacturing process; or, where said scented plug or insert may be installed on said shoe by non-factory aftermarket installers.
20. (Previously Amended) The plug or insert of claim 11, further comprising including where the installation of said scented plug or insert on said shoe by factory installers or by aftermarket installers allows for said installation to comprise any number and/or combination of different scented plugs or inserts, where differences comprising a given scented plug or insert comprising said any number and/or combination of different scented plugs or inserts can comprise any variation with regards to any one or more of the following: at least one material composition; at least one color; at least one scent and/or fragrance; at least one pheromone; at least one visual aspect; at least one smoking means; single sectional versus multi-sectional construction; ~~etc.~~, where the use of said different scented plugs or inserts allows for the customization of said shoe to comprise endless variants and permutations.

21. (Previously Amended) The plug or insert of claim 11, further comprising including where said scented plug or insert, and/or semi-solid scented plug or insert material, is made available and/or sold as a separately offered aftermarket item or plurality of aftermarket items, to allow customization of said shoe sole comprising said at least one void by aftermarket installers; further comprising including where said separately offered aftermarket item or said plurality of aftermarket items can be used to customize shoes other than said shoe through the modification of said shoes other than said shoe, where said modification comprises the creation of said at least one void by any void creating means that enables installation of said separately offered aftermarket item or said plurality of aftermarket items on said shoes other than said shoe.



**Evidence Appendix Under 41.37(c)(1)(ix)**

NONE.

There is no related evidence under 37 C.F.R. 1.130, 1.131, or 1.132 being filed with this Brief on Appeal.

**Related Proceedings Appendix Under 41.37(c)(1)(x)**

NONE.

There are no related proceedings pursuant to 41.37(c)(1)(ii).